

**REMARKS**

Upon entry of this Amendment:

- Claim 41, 53, 65, 67, 70, 72-74 and 77 will be amended
- Claims 61-64, 68-69, 71, 75-76 and 78-79 will be cancelled
- Claims 41, 51-53, 59-60, and 77 will be the only independent claims (7 independent claims)

Applicants have amended independent Claims 41, 53 and 77 for purposes of clarification by reciting what was implicit. No amendment was made for a reason related to patentability.

**A. OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTION**

Claims 53-57, 59-61 and 77 stand rejected for obviousness-type double patenting in light of U.S. Patent No. 6,263,505.

A terminal disclaimer is filed herewith to obviate the double patenting rejection. Nevertheless, Applicants do not agree that a *prima facie* case of double patenting has been made. For example, the rejection of claim 60 is based on the following motivation to modify the patented claims: "It would have been obvious to use an apparatus comprise [sic] a processor; and 'computer readable medium' in order to perform the procedures of claim 7 automatically." Office Action, pages 3.

Clearly, this is not a motivation which the *prior art* provides. Thus, there is no *prima facie* showing that the claims are obvious. While we do not agree with this rejection, a terminal disclaimer is filed concurrently herewith solely to expedite the prosecution of the present application. Accordingly, the double patenting rejection of Claims 53-57, 59-61 and 77 is moot

**B. SECTION 102(e) REJECTIONS**

Claims 41, 47-71 and 75-80 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,240,555 issued to Shoff, et al. ("Shoff"). We respectfully traverse the Examiner's Section 102(e) rejection.

1. **Independent Claim 41**

We respectfully submit that Claim 41 is not anticipated by Shoff. Shoff does not teach or suggest all of the features of independent Claim 41.

(a) **Shoff Does Not Disclose All the Limitations of Independent Claim 41**

Applicants have amended Claim 41 for purposes of clarification to include the limitations:

- *initiating a computer program via a computer*
- *sending the program identification information and synchronization information to a remotely located server*

We have carefully reviewed the Shoff reference cited by the Examiner, without finding a teaching or suggestion of 1) *initiating a computer program via a computer*, 2) *receiving a video program, program identification information and synchronization information related to a video program via a display device independent of the computer*, 3) *sending the program identification information and synchronization information to a remotely located server* and 4) *displaying the supplemental information on the computer*.

In contrast, Shoff is devoid of any hint or suggestion of the above features, as recited in independent Claim 41. Shoff describes:

Each subscriber has a viewer computing unit 24. In the illustrated implementation, the viewer computing unit is embodied as a set-top box (STB) 26 coupled to a television (TV) 28...[i]nstead of a separate STB, however, a viewer computing unit can be incorporated into the TV itself.

[Column 4, lines 22-31.] Shoff thus describes a system in which a viewer receives both the video signals and the supplemental content to the same device. There is nothing in Shoff, however, that would suggest *receiving a video program, program identification information and synchronization information related to a video program via a display device independent of the computer*. Accordingly, there is nothing in Shoff that would suggest *receiving a video program, program identification information and*

*synchronization information related to a video program via a display device independent of the computer, much less displaying the supplemental information on the computer.*

As Shoff fails to teach each limitation of Claim 41, Shoff cannot anticipate Claim 41 under Section 102(e). Consequently, Applicants respectfully request reconsideration and withdrawal of the instant rejection with respect to Claim 41.

Since each of Claims 47-50, 65-67, 70, and 72-74 are dependent from independent Claim 41, Claims 47-50, 65-67, 70, and 72-74 are patentable at least for the same reasons discussed above.

## **2. Independent Claims 51-52**

Independent Claims 51-52 claim a computer readable medium and apparatus containing a computer readable medium, respectively, for performing the method of Claim 41. As such, Claims 51-52 are patentable at least for the same reasons discussed above. Consequently, Applicants respectfully request reconsideration and withdrawal of the instant rejection with respect to Claims 51-52.

## **3. Independent Claim 53**

We respectfully submit that Claim 53 is not anticipated by Shoff. Shoff does not teach or suggest all of the features of independent Claim 53.

### **(a) Shoff Does Not Disclose All the Limitations of Independent Claim 53**

Applicants have amended Claim 53 for purposes of clarification to include the limitations:

- *synchronizing the requested supplemental information to the video program displayed on a display device using the synchronization information*
- *transmitting the requested supplemental information to a computer independent of the display device*

We have carefully reviewed the Shoff reference cited by the Examiner, without finding a teaching or suggestion of 1) *synchronizing the requested supplemental information to the video program displayed on a display device using the synchronization information*, and 2 *transmitting the requested supplemental information to a computer independent of the display device*.

In contrast, Shoff is devoid of any hint or suggestion of the above features, as recited in independent Claim 53. Shoff describes:

Each subscriber has a viewer computing unit 24. In the illustrated implementation, the viewer computing unit is embodied as a set-top box (STB) 26 coupled to a television (TV) 28...[i]nstead of a separate STB, however, a viewer computing unit can be incorporated into the TV itself.

[Column 4, lines 22-31.] Shoff thus describes a system in which a viewer receives both the video signals and the supplemental content to the same device. There is nothing in Shoff, however, that would suggest *synchronizing the requested supplemental information to the video program displayed on a display device using the synchronization information and transmitting the requested supplemental information to a computer independent of the display device*.

As Shoff fails to teach each limitation of Claim 53, Shoff cannot anticipate Claim 53 under Section 102(e). Consequently, Applicants respectfully request reconsideration and withdrawal of the instant rejection with respect to Claim 53.

Since each of Claims 54-58 are dependent from independent Claim 58, Claims 54-58 are patentable at least for the same reasons discussed above.

#### 4. **Independent Claims 59-60**

Independent Claims 59-60 claim a computer readable medium and apparatus containing a computer readable medium, respectively, for performing the method of Claim 53. As such, Claims 59-60 are patentable at least for the same reasons discussed above. Consequently, Applicants respectfully request reconsideration and withdrawal of the instant rejection with respect to Claims 59-60.

**5. Independent Claim 77**

We respectfully submit that Claim 77 is not anticipated by Shoff. Shoff does not teach or suggest all of the features of independent Claim 77.

**(a) Shoff Does Not Disclose All the Limitations of Independent Claim 77**

Applicants have amended Claim 77 for purposes of clarification to include the limitations:

- *displaying a video program including an audio component, a visual component and synchronization information via a display device*
- *receiving the supplemental information from the remotely located server; and*
- *displaying the requested supplemental information via the computer, synchronized to the video program in accordance with the synchronization information*

We have carefully reviewed the Shoff reference cited by the Examiner, without finding a teaching or suggestion of 1) *displaying a video program including an audio component, a visual component and synchronization information via a display device*, 2) *receiving the supplemental information from the remotely located server; and* 3) *displaying the requested supplemental information via the computer, synchronized to the video program in accordance with the synchronization information*

In contrast, Shoff is devoid of any hint or suggestion of the above features, as recited in independent Claim 77. Shoff describes:

Each subscriber has a viewer computing unit 24. In the illustrated implementation, the viewer computing unit is embodied as a set-top box (STB) 26 coupled to a television (TV) 28...[i]nstead of a separate STB, however, a viewer computing unit can be incorporated into the TV itself.

[Column 4, lines 22-31.] Shoff thus describes a system in which a viewer receives both the video signals and the supplemental content to the same device. There is

nothing in Shoff, however, that would suggest *displaying a video program including an audio component, a visual component and synchronization information via a display device* and *displaying a video program including an audio component, a visual component and synchronization information via a display device*.

As Shoff fails to teach each limitation of Claim 77, Shoff cannot anticipate Claim 77 under Section 102(e). Consequently, Applicants respectfully request reconsideration and withdrawal of the instant rejection with respect to Claim 77.

Since Claim 80 is dependent from independent Claim 77, Claim 80 is patentable at least for the same reasons discussed above.

### C. SECTION 103(a) REJECTIONS

Claims 72-74 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Shoff, and further in view of U.S. Patent No. 6,014,184 issued to Knee, et al. ("Knee"). We respectfully traverse the Examiner's Section 103(a) rejection.

#### 1. Factual Inquiries Required by *Graham* for Determination of Obviousness Under 35 U.S.C. § 103

In Graham v. John Deere Co., 383 U.S. 1, 148 U.S.P.Q. 459 (1966), the Supreme Court established the test for consideration and determination of obviousness under 35 U.S.C. § 103. U.S. Patent and Trademark Office policy is to follow Graham. Accordingly, examiners should apply the test for patentability under 35 U.S.C. § 103 as set forth in Graham. M.P.E.P. § 2141 (8<sup>th</sup> ed. (Rev. 1), Feb. 2003).

The four factual inquiries enunciated in Graham as a background for determining obviousness of a claim are as follows:

- a) Resolving the level of ordinary skill in the pertinent art;
- b) Determining the scope and contents of the prior art;
- c) Ascertaining the differences between the prior art and the claims in issue;  
and
- d) Evaluating evidence of secondary considerations.

M.P.E.P. § 2141. Some of these factual inquiries are discussed briefly below.

**a) Level of Ordinary Skill in the Art**

Ascertaining a level of ordinary skill in the art is necessary. M.P.E.P. § 2141.03. See Ryko Mfg. Co. v. Nu-Star, Inc., 950 F.2d 714, 718 (Fed. Cir. 1991) (“Hence, the level of ordinary skill in the art is a factual question that must be resolved and considered.”). Some factors that may be considered are outlined at M.P.E.P. § 2141.03.

Without a factual determination of the level of ordinary skill in the art, obviousness cannot be assessed properly because the critical question is whether a claimed invention would have been obvious at the time it was made to one with ordinary skill in the art. Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc., 807 F.2d 955, 962 (Fed. Cir. 1986).

Thus, a determination of the level of ordinary skill in the art is an integral part of the Graham analysis. Ruiz v. A.B. Chance Co., 234 F.3d 654, 666 (Fed. Cir. 2000) (citing Custom Accessories, 807 F.2d at 962).

**b) Scope and Content of the Prior Art**

To rely on a reference under 35 U.S.C. § 103, the reference must be analogous prior art. M.P.E.P. § 2141.01(a). Also, in order to avoid impermissible hindsight, the content of the prior art must be determined as of the time the invention was made. M.P.E.P. § 2141.01.

**c) Differences between the Prior Art and the Claims**

Ascertaining the differences between the prior art and the claims at issue requires (i) interpreting the claim language, and (ii) considering both the invention and the prior art references as a whole. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. M.P.E.P. § 2141.02 (emphasis in original).

**2. Prima Facie Case of Obviousness**

In view of all factual information, the Examiner must then make a determination whether the claimed invention “as a whole” would have been obvious to the hypothetical

“person of ordinary skill in the art” when the invention was unknown and just before it was made. M.P.E.P. § 2142.

a) **Basic Requirements**

To establish a *prima facie* case of obviousness for a claim, three basic criteria must be met:

1. There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art;
2. There must be some reasonable expectation of success; and
3. The prior art reference (or references when combined) must teach or suggest all the claim limitations.

See M.P.E.P. § 2143.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. § 2143.01.

b) **The Examiner Bears the Initial Burden of Factual Support**

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. M.P.E.P. § 2142. The initial burden, therefore, is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. M.P.E.P. § 2142.

c) **The Examiner has Failed to Conduct the Required Graham Inquiries**

We have carefully reviewed the Section 103 rejections of Claims 72-74 in the present Office Action to determine compliance with the Graham requirements. We respectfully submit that the Examiner has not followed Graham with respect to any rejection under Section 103.



Specifically, the Examiner has neither

- (i) defined a level of ordinary skill in the art, nor
- (ii) clearly indicated any evidence in support of such a finding.

Such findings are necessary in assessing obviousness. M.P.E.P. § 2141.03.

As a result of the failure to resolve and consider the level of ordinary skill, the Examiner (i) cannot have determined the scope and content of the prior art objectively, i.e., from the point of view of the hypothetical person having ordinary skill in the art at the time of invention, and thus (ii) cannot have determined the differences between the cited references and the claims objectively.

As the Examiner has failed to conduct the required Graham factual inquiries, the Examiner cannot factually support any *prima facie* conclusion of obviousness with respect to any pending claim.

**d) Request for Factual Support**

In any subsequent Office Action asserting a Section 103 rejection, we respectfully request that the Examiner clearly indicate, with respect to each rejected claim, the support in the record for any findings under the required Graham factual inquiries: (i) the level of ordinary skill in the pertinent art; (ii) the scope and contents of the prior art; (iii) the differences between the prior art and the claims in issue; and (iv) any evidence of secondary considerations.

In particular, we respectfully request that the Examiner define and submit evidence of the level of ordinary skill. Some factors that may be considered in determining the ordinary level of skill in the art are outlined at M.P.E.P. § 2141.03.

**e) The Examiner has Failed to Meet the Basic Criteria for  
*Prima Facie* Obviousness**

The Examiner has failed to make the requisite factual findings required under Graham (outlined above) and thus cannot factually support a *prima facie* conclusion of obviousness with respect to any claim.

For example, without resolving the level of ordinary skill in the art, the Examiner has no factual support for an assertion that either (a) a claimed feature or (b) a motivation to combine / modify references may be found objectively either (i) in the references themselves, (ii) in the knowledge generally available to one of ordinary skill in the art, or (iii) in the nature of the problem to be solved.

In addition, the Examiner has failed to make any assertion of a reasonable expectation of success with respect to any claim.

For at least these reasons, we respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness for any pending claim.

Some criteria that have not been met with respect to particular claims are discussed further herein.

### 3. Claims 72-74

We respectfully submit that independent Claims **72-74** are not obvious in light of Shoff or Knee, either alone or in combination. First, neither Shoff nor Knee teach or suggest all of the features of Claims **72-74**.

Second, there is no suggestion or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art, to modify or to combine the cited references to provide for all of the claimed features of independent Claim **72-74**.

#### a. The References Do Not Disclose All the Limitations of Independent Claims 72-74

As stated above with respect to the Examiner's Section 102(e) rejection of Claim **41**, Shoff fails to disclose every limitation of the independent claim from which Claims **72-74** depend. As such, the Examiner's attempt to combine Knee with Shoff to teach all of the limitations of Claims **72-74** fails.

#### b. No Motivation to Combine the Cited References

As best understood by us, the Examiner also asserts the following to be true with respect to the claims:

- Claim 72: It would have been obvious to one of ordinary skill in the art to modify Shoff in light of Knee to provide for a feature of *initiating payment*

The motivations for this modification would be improve convenience for user to purchase [sic] product

- Claim 73: It would have been obvious to one of ordinary skill in the art to modify Shoff in light of Knee to provide for a feature of *providing payment using a credit card account*

The motivations for this modification would be to improve convenience for user to purchase [sic] product

- Claim 74: It would have been obvious to one of ordinary skill in the art to modify Shoff in light of Knee to provide for a feature of *providing payment of a service statement*

The motivations for this modification would be to improve convenience for user to purchase [sic] product

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 706.02(j). In re Fine, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 21 USPQ2d 1941 (Fed. Cir. 1992).

In view of the above, the Examiner must show that the prior art of record provides the motivation of (d) above. MPEP 2143. Further, the Examiner must show that the asserted subject matter of (d) above includes a teaching, suggestion, or motivation to make the proposed combination or modification of the asserted teachings of the prior art to produce the specific features of the claimed invention.

3. **The Asserted Motivation is Not Shown in the Cited  
References**

We have carefully reviewed the Office Action issued in the present application, as well as the Shoff and Knee references cited by the Examiner, without finding a motivation anywhere in the record that suggests the desirability of combining or modifying the cited references in the manner proposed by the Examiner.

The Examiner does not assert otherwise.

Applicants respectfully assert that the Examiner has failed to present a *prima facie* case of obviousness with respect to the instant claim as neither of the references teach or suggest all of the limitations of the claims, nor has the Examiner provided a motivation present within the record to combine the references in the manner suggested by the Examiner to teach or suggest all of the limitations of the instant claims. As such, Applicants respectfully request reconsideration and withdrawal of the Section 103(a) rejection with respect to Claims **72-74**.

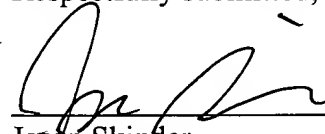
**CONCLUSION**

It is submitted that all of the claims are in condition for allowance. The Examiner's early re-examination and reconsideration are respectfully requested.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Jason Skinder at telephone number 203-461-7017 or via electronic mail at [jskinder@walkerdigital.com](mailto:jskinder@walkerdigital.com).

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Date

Respectfully submitted,



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